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10/081,029**D. REMARKS***Specification*

Applicants have amended the specification above to include the application serial numbers of the related cross-references.

Interview Summary

On April 4, 2005 around 10 AM est, an interview was conducted via telephone between Amy Pattillo, Applicants' Representative, and Examiner Barry Taylor. No exhibits were shown, nor demonstrations conducted.

Applicants' representative and the Examiner discussed claim 1, and in particular a proposed attached amendment to claim 1. Specifically, the prior art cited against claim 1 is the US Patent to Morganstein (US Patent Number 5,724,408) in view of Kurganov (US Patent Number 6,807,257).

In particular, Applicants' representative requested a clarification of where the Examiner addresses the amended elements of claim 1 that teach "wherein a third party makes telephone service available to said first party for said call" or "a selection of context based criteria specified by said third party." The Examiner responded that these claim limitations read on a service that a parent sets up for a child as taught in Morganstein or any PBX or answering system. In addition, the Examiner responded that the claim is ambiguous because it does not teach how the service is set up or how the third party subscribes to the telephone service. Applicants' representative argued that the Morganstein still only teaches monitoring incoming calls and not controlling outgoing calls.

In addition, Applicants' representative and the Examiner discussed claim 16 and in particular Applicants' representative requested clarification of how Kurganov teaches context indicating at least one from among a location of said first party, a type of telephony device used by said first party, and a device used to authenticate an identity of said first party. The Examiner responded that Morganstein teaches using the originating calling number to identify a first party.

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Further, the Examiner suggested clarifying the scope of "context" to include the path of the call and other elements taught in the specification. Applicants' representative agreed to consider additional claims to clarify the scope of "context". In conclusion, no agreement with respect to the claims was reached. Applicants are filing this response with the amended claims for further review by the Examiner.

37 CFR 1.131 Affidavit

The Examiner cites Kuhn et al (US Patent 6,724,866) as prior art in the rejection of claims 1-54 under 35 USC 103(a). "Before answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Subject matter that is prior art under 35 U.S.C. 102 can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981). When the reference is not a statutory bar under 35 U.S.C. 102(b), (c), or (d), applicant can overcome the rejection by swearing back of the reference through the submission of an affidavit under 37 CFR 1.131. *In re Foster*, 343 F.2d 980, 145 USPQ 166 (CCPA 1965).

First, the reference is not a statutory bar under 102(b). 35 U.S.C. 102(b) requires: the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. Kuhn's filing date is February 8, 2002. The filing date for the present invention is February 21, 2002. Since Kuhn's filing date does not precede the filing date of the present invention by more than 1 year, Kuhn does not create a statutory bar under 102(b).

Second, the reference is not a statutory bar under 102(a) or any other section of 102. Section (a) of 37 CFR 1.131 requires that when any claim of an application is rejected, the inventor of the subject matter of the rejected claim or the party qualified under sections 1.42, 1.43 or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference on which the rejection is based. In addition, section (b) of 37 CFR 1.131 requires "the showing of facts shall be such, in

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character and weight, as to establish reduction, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application." Applicants file an affidavit signed by the inventors with this paper in compliance with 37 CFR 1.131 states facts that show that prior to February 8, 2002, the inventors had completed the conception of the subject matter of rejected claims 1-54. A copy of the disclosure submitted by the inventors which includes drawings of a model of the invention. In addition, as the dates show, Applicants followed the conception of the subject matter prior to the invention date with reasonable diligence by filing the application for a patent only 13 days after the effective reference date.

Therefore, because Kuhn cannot be used as prior art under 102, Kuhn also cannot be used as prior art under 103. Applicants respectfully request allowance of claims 1-2, 4-7, 9-12, 16-26, 30-36, 40-46, and 50-54 which are rejected under Morganstein in view of Kuhn.

Applicants previously filed an affidavit on 9/20/2004 under 37 CFR 1.131. Applicants note that the Examiner considered the affidavit, but that the affidavit was ineffective to overcome Kuhn because the affidavit was unsigned and therefore not considered. [Office Action, p. 2] In particular, the affidavit was previously unsigned by Michael Brown. In this response, Applicants submit a fully signed copy of the previously submitted affidavit.

35 USC § 103(a)

1. Claims 1-2, 4-7, 9-12, 16-26, 30-36, 40-46, and 50-54 are not obvious under Morganstein in view of Kuhn

Claims 1-2, 4-7, 9-12, 16-26, 30-36, 40-46, and 50-54 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morganstein (US Patent Number 5,724,408) in view of Kuhn et al. (US Patent Number 6,724,866, hereinafter Kuhn). Applicants submit that Kuhn cannot be prior art cited against the present invention based on the affidavit under 37 CFR 1.131, however, in the event that Kuhn continues to be cited against the present invention, Applicants present the

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following arguments and amendments in response to the rejections based on 35 USC 103(a). In particular, the Examiner carries the burden of proving a *prima facie* case of obviousness for a 103(a) rejection. As amended, claims 1-2, 4-7, 9-12, 16-26, 30-36, 40-46, and 50-54 are not obvious in view of Morganstein in view of Kuhn and therefore the rejection should be withdrawn and the claims allowed.

Claims 1, 6, and 11

With regards to claims 1, 6, and 11, independent method claim 1, which is representative of independent system claim 6 and independent computer program product claim 11, with regard to similarly recited subject matter and rejection, reads as follows:

1. (Previously Amended) A method for regulating calls, comprising:
 - detecting a context for a call from a first party to a second party via a particular line, wherein a third party subscribes to a telephone service made available to said first party for said call;
 - comparing said context for said call with a selection of context based criteria for said particular line specified by said third party; and
 - only establishing a communication channel between said first party and said second party through said particular line if said context is acceptable within said selection of context based criteria.

In the rejection of claim 1, the Examiner cites Morganstein as teaching:

“detecting a context for a call from a first party to second party (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)”, “comparing the context for the call with a selection of context based criteria for particular line (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)”, and “only establishing a communication channel between the first party and second party through the particular line if the context is acceptable within the selection of context based criteria (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58).” [Office Action, p. 3]

The Examiner notes, however, that Morganstein does not “explicitly show regulating calls”.

[Office Action, p. 3] The Examiner states that Kuhn cites Morganstein

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"wherein call screener used to elicit speech from incoming caller whereby the telephony system routes calls based on comparison of the elicited speech to a set of stored speaker models (abstract). Kuhn discloses that the context for call may be used to determine "company affiliation" of caller (columns 1-2, see server based system column 2). Kuhn further shows context used to determine different classes of callers whereby different actions to be taken (col. 2 lines 34-64, col. 3 lines 3-4). Kuhn even discloses regulating based upon time context (col. 4 lines 37-63). Kuhn allows for dynamic context information as well. For example, if user wants to regulate calls from a rare coin vendor, the user simply creates context information to be used to regulate "coin vendors" (col. 4 line 19-col. 5 line 63). Kuhn discloses that user is able to define any type of criteria to be used as context thereby filtering telephony calls (col. 4 line 64-col. 5 line 7)." [Office Action, pp. 3-4]

Thus, the Examiner concludes that it would have been obvious for anyone of ordinary skill in the art at the time of invention to "modify the processor as taught by Morganstein to use context based criteria as taught by Kuhn for the benefit of allowing user to dynamically select desired call context to be used as filtering criteria as taught by Kuhn." [Office Action, p. 4]

The Examiner carries the burden of proving a *prima facie* case of obviousness for a 103(a) rejection. In particular, in establishing a *prima facie* case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Appellants respectfully note that the Examiner does not show, nor do the references teach or suggest, separately or in combination, detecting a context for a call from a first party to a second party via a particular line, wherein a third party subscribes to a telephone service made available to said first party for said call or comparing said context for said call with a selection of context based criteria for said particular line specified by said third party.

The Examiner states the same ground of rejection of claim 1 as was stated in the previous office action dated 6/18/2004 with one additional citation of col. 4 line 64 through col. 5 line 7 of AUS920010846US1

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Kuhn that the Examiner summarizes as "Kuhn discloses that user is able to define any type of criteria to be used as context thereby filtering telephony calls". [Office Action, p. 4] Col. 4 line 64 through col. 5 line 7 read:

In some applications, a user may wish to permit a caller of unknown identity to ring through, if that caller is able to supply certain prearranged or preassigned information. For example, if the user is expecting to receive a call from a rare coin vendor, in response to a previous inquiry, the user can generate a user defined record in the acceptable caller database to accommodate this.

Specifically, the user would create an entry such that any caller who mentions the word "coin" or "coins" in response to a prompt would be permitted to ring through. The multipurpose dialogue system 40 is programmed to the user to ask the incoming caller to state the caller's name and purpose of the call.

Responsive to the Office Action dated 6/18/2004, Applicants filed an amendment dated 9/20/2004 in which Applicants amended claim 1 to indicate that a third party telephone service subscriber makes available the telephone service used by the first party placing the call and that the selection of context based criteria is specified by the third party. In particular, Applicants amended claim 1 as follows:

1. (As amended in the response dated 9/20/2004) A method for regulating calls, comprising:

detecting a context for a call from a first party to a second party via a particular line, wherein a third party subscribes to a telephone service made available to said first party for said call;

comparing said context for said call with a selection of context based criteria for said particular line specified by said third party; and

only establishing a communication channel between said first party and said second party through said particular line if said context is acceptable within said selection of context based criteria.

First, in response to the Examiner's new ground of rejection, Applicants assert that the Examiner's summary of the disclosure of Kuhn col. 4 line 64 through col. 5 line 7 is an overstatement of the disclosure of Kuhn and therefore Morganstein in view of Kuhn does not teach or suggest each and every element of claim 1. In particular, the Examiner states that in col. 4 line 64 through col. 5 line 7 "Kuhn discloses that user is able to define any type of criteria to be used as context thereby filtering telephony calls."

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[Office Action, p. 4] Kuhn, however, discloses that a user can regulate incoming calls by specifying which callers get to ring through on a receiving line after responding to a prompt in a particular way; callers who do not respond to the prompt in a particular way are rerouted to an automated answering system. (See Kuhn, col. 4 line 64-col. 5 line 7 disclosing that a user can set the words that must be spoken by a caller in response to a prompt in order for the call to then ring through without first determining the actual identity of the caller). Applicants assert, however, that enabling a user to regulate which incoming calls get to ring through on a receiving line if the caller responses to a prompt in a particular way, as disclosed by Kuhn, does not teach the Examiner's assertion that a "user is able to define any type of criteria to be used as a context thereby filtering telephone calls".

Second, Applicants assert that the Examiner's statement that the element missing in the teachings of Morganstein is "regulating calls" is incorrect, leading to a rejection under Morganstein in view of Kuhn that does not teach or suggest each and every element of claim 1. The Examiner cites Morganstein as teaching the elements of claim 1, except for wherein a third party subscribes to a telephone service made available to said first party for said call and a selection of context based criteria for said particular line specified by said third party. The Examiner improperly summarizes these elements as "regulating calls" and cites Kuhn as disclosing "regulating calls". Morganstein and Kuhn, however, only disclose regulation of an incoming call. In particular, Morganstein and Kuhn both disclose systems for call screening of incoming calls to a particular line, not regulating outgoing calls from a particular line. (See Morganstein abstract and col. 2, lines 15-59 and Kuhn abstract and col. 2 line 66-col. 3 line 21 where Morganstein enables a user to set how an incoming call is handled based on the caller telephone number and Kuhn enables a user to specify dialogue for prompting a caller of an incoming call to produce and routing the incoming call based on the caller response to the dialogue). Neither Morganstein nor Kuhn, individually or in combination, teaches regulating outgoing calls from a particular line. In contrast, claim 1 teaches regulating

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outgoing calls from a particular line made available by a third party (the first party places the call) based on third party criteria specified for the outgoing call line. In particular, when considered as a whole, claim 1 teaches that the third party supplies the line used by the first party, or caller, for an outgoing call and that a communication channel is allowed to open for an outgoing call from the first party to the second party only if the context of the call between the first party and the second party is acceptable within a selection of context based criteria specified by the third party for the line. Therefore, because claim 1 teaches regulating outgoing calls and Morganstein in view of Kuhn only teaches regulating incoming calls, Morganstein combined with Kuhn fails to teach detecting a context for a call from a first party to a second party via a particular line, wherein a third party subscribes to a telephone service made available to said first party for said call or comparing said context for said call with a selection of context based criteria for said particular line specified by said third party.

In conclusion, a prima facie case of obviousness under 103(a) is not established for claims 1, 6, and 11 because at least one element of claims 1, 6, and 11 is not taught. Because a prima facie case of obviousness under 103(a) is not established for the claims 1, 6, and 11, Appellants respectfully request allowance of claims 1, 6, and 11.

Claims 2, 4, 5, 7, 9, 10, and 12

Regarding claims 2, 4, 5, 7, 9, 10, and 12, Applicants respectfully propose that because claims 1, 6, and 11 are no longer obvious under Morganstein in view of Kuhn, as claims dependent upon claims 1, 6, and 11, claims 2, 4, 5, 7, 9, 10, and 12 are not obvious under Morganstein in view of Kuhn and the dependent claims should be allowed.

Claim 14

With regard to claim 14, claim 14 currently reads:

14. (Original) A method for regulating outgoing calls, comprising:
detecting an identity of a party called via a particular line;

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determining a selection of third party criteria governing calls via said particular line according to said identity of said called party; and
only establishing a communication channel via said particular line between a calling party and called party if said called party is acceptable within said selection of third party criteria.

The Examiner continues to reject claim 14 under the same grounds of rejection stated in the office action dated 6/10/2004. In particular, in rejecting claim 14, the Examiner first states that Morganstein fails to show "third party criteria". [Office Action, p. 5] Then, the Examiner states that Kuhn cites Morganstein:

"wherein call screener used to elicit speech from incoming caller whereby the telephony system routes calls based on comparison of the elicited speech to a set of stored speaker models (abstract). Kuhn discloses that the context for call may be used to determine "company affiliation" of caller (columns 1-2). Kuhn further shows context used to determine different classes of callers whereby different actions to be taken (col. 2 lines 34-64, col. 3 lines 3-4). Kuhn even discloses regulating based upon time context (col. 4 lines 37-63). Kuhn allows for dynamic context information as well. For example, if user wants to regulate calls from a rare coin vendor, the user simply creates context information to be used to regulate "coin vendors" (col. 4 line 19-col. 5 line 63)." [Office Action, p. 5]

Thus, the Examiner concludes that it would have been obvious for anyone of ordinary skill in the art at the time of invention to "modify the processor as taught by Morganstein to use context based criteria as taught by Kuhn for the benefit of allowing user to dynamically select desired call context to be used as filtering criteria as taught by Kuhn." [Office Action, p. 6]

In establishing a *prima facie* case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that *prima facie* obviousness is not established because Morganstein in view of Kuhn does not teach any of the claim limitations when claim 14 is considered as a whole.

First, Applicants respectfully assert that the Examiner fails to establish a case of *prima facie* obviousness for claim 14 because Morganstein does not teach all the elements of claim 14, except for "third party criteria". In the rejection of claim 14, the Examiner assumes that Morganstein teaches claim 14, except for "third party criteria". [Office Action, p. 5] While the

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Examiner does not point to which sections of Morganstein teach or suggest all the elements of claim 14 except for “third party criteria”, Applicants traverse the rejection and assert that when considered as a whole, claim 14 teaches regulating an outgoing call placed via a particular line based on the third party criteria governing calls via the outgoing line to the actual callee receiving the call (the party called via the line). Morganstein and Kuhn, in contrast, disclose call screening of incoming calls to a particular line, not regulating outgoing calls from a particular line. (See Morganstein col. 2, lines 15-59 and Kuhn col. 2 line 66-col. 3 line 21). Morganstein enables a user to set how an incoming call is routed based on the caller telephone number. (See Morganstein, abstract). Therefore, because Morganstein does not teach outgoing call regulation, Morganstein does not teach each element of claim 14 except for “third party criteria”.

Second, Applicants respectfully assert that the Examiner fails to establish a case of *prima facie* obviousness for claim 14 because Kuhn does not teach “third party criteria” when claim 14 is interpreted as a whole and “third party criteria” is applied to regulating an outgoing call. In particular, Applicants assert that Kuhn only discloses a call screening system that detects the identity of a caller from an incoming call and routes the call according to filtering rules for the caller’s identity. (See Kuhn, col. 4 line 64-col. 5 line 7). Kuhn focuses on routing an incoming call based on the identity of the caller (See Kuhn col. 3 lines 3-21); Kuhn does not teach detecting the actual identity of the party answering the call, selecting criteria based on the actual identity of the party answering the call, and routing the call based on the criteria. In contrast, claim 14 teaches detecting the identity of the called party, selecting criteria according to the identity of the called party and only establishing a communication channel from the calling party to the called party if the identity of the called party is acceptable within the criteria. Therefore, because Kuhn does not teach regulating an outgoing call according to “third party criteria”, Morganstein combined with Kuhn does not teach or suggest each element of claim 14.

In conclusion, Morganstein in view of Kuhn does not teach outgoing call regulation and therefore Morganstein in view of Kuhn also does not teach outgoing call regulation based on third party criteria applied to the outgoing call line. Therefore, *prima facie* case of obviousness under 103(a) is not established for claim 14 because at least one element of claim 14 is not

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taught. Because a prima facie case of obviousness under 103(a) is not established for claim 14, Appellants respectfully request allowance of claim 14.

Claims 16, 19, and 22

With regards to claims 16, 19, and 22, independent method claim 16, which is representative of independent system claim 19 and independent computer program product claim 22, with regard to similarly recited subject matter and rejection, reads as follows:

16. (Previously Amended) A method for screening calls, comprising:
detecting a context for a call from a first party to a second party, wherein
said context indicates at least one from among a location of said first party, a type
of telephony device used by said first party, and a device used to authenticate an
identity of said first party; and
responsive to said context requiring prescreening of said call, transferring
said call to a screening party.

In the rejection of claims 16, 19, and 22, the Examiner cites Morganstein as teaching:

“detecting a context for a call from a first party to second party (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 5 lines 1-36, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)”,
“comparing the context for the call with a selection of context based criteria for
particular line (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines
24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines
27-58)”, and “only establishing a communication channel between the first party
and second party through the particular line if the context is acceptable within the
selection of context based criteria (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4
line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8
line 54, col. 9 lines 27-58).” [Office Action, p. 6]

The Examiner notes, however, that Morganstein does not explicitly show a call screener. [Office Action, p. 6] The Examiner notes that Kuhn cites Morganstein

“wherein call screener used to elicit speech from incoming caller whereby the
telephony system routes calls based on comparison of the elicited speech to a set
of stored speaker models (abstract). Kuhn discloses that the context for call may
be used to determine “company affiliation” of caller (columns 1-2). Kuhn further
shows context used to determine different classes of callers whereby different
actions to be taken (col. 2 lines 34-64, col. 3 lines 3-4). Kuhn even discloses
regulating based upon time context (col. 4 lines 37-63). Kuhn allows for dynamic
context information as well. For example, if user wants to regulate calls from a

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rare coin vendor, the user simply creates context information to be used to regulate “coin vendors” (col. 4 line 19-col. 5 line 63).” [Office Action, pp. 6-7]

Thus, the Examiner concludes that it would have been obvious for anyone of ordinary skill in the art at the time of invention to “modify the processor as taught by Morganstein to use context based criteria as taught by Kuhn for the benefit of allowing user to dynamically select desired call context to be used as filtering criteria as taught by Kuhn.” [Office Action, p. 7]

In establishing a *prima facie* case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that the Examiner nor the references teach or suggest, separately or in combination, detecting a context for a call from a first party to a second party, wherein said context indicates at least one from among a location of said first party, a type of telephony device used by said first party, and a device used to authenticate an identity of said first party.

In particular, the Examiner does not show how Morganstein in view of Kuhn teaches the “context” element where the “context” indicates at least one from among a location of said first party, a type of telephony device used by said first party, and a device used to authenticate an identity of said first party. In an amendment dated 9/10/2004, Applicants amended claim 16 to include the limitation that the context may include “at least one from among a location of said first party (p. 7 line 19), a type of telephony device used by said first party (p. 7 line 18), and a device used to authenticate an identity of said first party (p. 30 line 13).” As previously asserted by Applicants, neither Morganstein nor Kuhn teach or suggest detecting the context that indicates the location of the first party (such as by GPS), the type of telephony device used by the first party (such as a cellular phone), or the device used to authenticate an identity of the first party (such as a third party authentication system). Further, the Examiner does not respond to the amendments to claim 16 in the current rejection to show how Morganstein or Kuhn, separately or in combination, teaches detecting context that includes any of the amended elements.

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In conclusion, prima facie case of obviousness under 103(a) is not established for claim 16 because at least one element of claim 16 is not taught. Because a prima facie case of obviousness under 103(a) is not established for claim 16, Appellants respectfully request allowance of claims 16, 19, and 22.

Claims 17, 18, 20, 21, 23, and 24

Regarding claims 17, 18, 20, 21, 23, and 24, Applicants respectfully propose that because claims 16, 19, and 22 are no longer obvious under Morganstein in view of Kuhn, as claims dependent upon claims 16, 19, and 22, claims 17, 18, 20, 21, 23, and 24 are not obvious under Morganstein in view of Kuhn and the dependent claims should be allowed.

Claims 25, 35, and 45

With regards to claims 25, 35, and 45, independent method claim 25, which is representative of independent system claim 35 and independent computer program product claim 45, with regard to similarly recited subject matter and rejection, reads as follows:

25. **(Currently Amended)** A method for regulating calls, comprising:
detecting an identity of a caller placing a call from a particular line number, wherein a third party independent of said caller subscribes for said particular line number;
accessing regulation criteria specified by said third party and relevant to said caller identity for said particular line number; and
regulating said call according to said relevant regulation criteria, such that said third party is enabled to regulate calls [to] from said particular line number without being a direct party to said call.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). The Examiner cites Morganstein as teaching

“detecting a context for a call from a first party to second party (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 5 lines 1-36, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)”,
“comparing the context for the call with a selection of context based criteria for particular line (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines

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24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)", and "only establishing a communication channel between the first party and second party through the particular line if the context is acceptable within the selection of context based criteria (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)." [Office Action, p. 9]

The Examiner notes, however, that Morganstein does not explicitly show "regulating calls".

[Office Action, p. 9] The Examiner notes that Kuhn cites Morganstein

"wherein call screener used to elicit speech from incoming caller whereby the telephony system routes calls based on comparison of the elicited speech to a set of stored speaker models (abstract). Kuhn discloses that the context for call may be used to determine "company affiliation" of caller (columns 1-2). Kuhn further shows context used to determine different classes of callers whereby different actions to be taken (col. 2 lines 34-64, col. 3 lines 3-4). Kuhn even discloses regulating based upon time context (col. 4 lines 37-63). Kuhn allows for dynamic context information as well. For example, if user wants to regulate calls from a rare coin vendor, the user simply creates context information to be used to regulate "coin vendors" (col. 4 line 19-col. 5 line 63)." [Office Action, pp. 9-10]

Thus, the Examiner concludes that it would have been obvious for anyone of ordinary skill in the art at the time of invention to "modify the processor as taught by Morganstein to use context based criteria as taught by Kuhn for the benefit of allowing user to dynamically select desired call context to be used as filtering criteria as taught by Kuhn." [Office Action, p. 10]

In establishing a *prima facie* case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Previously, Applicants amended claim 25 to indicate that a third party telephone service subscriber makes available the telephone service used by the first party placing the call and that outgoing calls from that telephone service are regulated according to criteria selected by the third party. (See Specification p 7, lines 6-8). Applicants respectfully assert that when considered as a whole, claim 25 teaches regulating an outgoing call placed via a particular line based on the third party criteria governing calls by the identified caller via the outgoing line. Morganstein and Kuhn, in contrast, disclose call screening of incoming calls to a particular line, not regulating outgoing calls from a particular line. (See Morganstein col. 2,

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lines 15-59 and Kuhn col. 2 line 66-col. 3 line 21). Morganstein enables a user to set how an incoming call is handled based on the caller telephone number. (See Morganstein, abstract). Kuhn enables a user to specify dialogue for prompting a caller of an incoming call to produce and routing the incoming call based on the caller response to the dialogue. (see Kuhn, Abstract). Thus, Morganstein combined with Kuhn discloses an incoming call screening system based on the caller telephone number or inputs made by the caller responsive to prompting by the call screening system. Therefore, because neither Morganstein nor Kuhn teaches outgoing call regulation, Morganstein combined with Kuhn also does not teach outgoing call regulation by third party criteria selected according to the identity of the caller. Additionally, Applicants note that claim 25 is amended to clarify that the third party regulates calls from the particular line.

In conclusion, *prima facie* case of obviousness under 103(a) is not established for claim 25 because at least one element of claim 25 is not taught. Because a *prima facie* case of obviousness under 103(a) is not established for claim 25, Appellants respectfully request allowance of claims 25, 35, and 45. .

Claims 26, 30-34, 36, 40-44, 46, and 50-54

Regarding claims 26, 30-34, 36, 40-44, 46, and 50-54, Applicants respectfully propose that because claims 25, 35, and 45 are not obvious under Morganstein in view of Kuhn, as claims dependent upon claims 25, 35, and 45, claims 26, 30-34, 36, 40-44, 46, and 50-54 are not obvious under Morganstein in view of Kuhn and the dependent claims should be allowed.

2. Claims 1-2, 4-7, 9-12, 16-26, 30-36, 40-46, and 50-54 are not obvious under Morganstein in view of Kurganov

Claims 1-2, 4-7, 9-12, 16-26, 30-36, 40-46, and 50-54 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morganstein (US Patent Number 5,724,408) in view of Kurganov (US Patent Number 6,807,257). The Examiner carries the burden of proving a *prima facie* case of obviousness for a 103(a) rejection. As previously amended, claims 1-2, 4-7, 9-12,

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16-26, 30-36, 40-46, and 50-54 are not obvious in view of Morganstein in view of Kurganov and therefore the rejection should be withdrawn and the claims allowed.

Claims 1, 6, and 11

With regards to claims 1, 6, and 11, independent method claim 1, which is representative of independent system claim 6 and independent computer program product claim 11, with regard to similarly recited subject matter and rejection, reads as follows:

- 1.(Previously Amended) A method for regulating calls, comprising:
 - detecting a context for a call from a first party to a second party via a particular line, wherein a third party subscribes to a telephone service made available to said first party for said call;
 - comparing said context for said call with a selection of context based criteria for said particular line specified by said third party; and
 - only establishing a communication channel between said first party and said second party through said particular line if said context is acceptable within said selection of context based criteria.

Applicants amended claim 1 in the response dated 9/28/2004. The Examiner cites Morganstein as disclosing “detecting a context for a call from a first party to a second party”, “comparing the context for the call with a selection of context based criteria for particular line”, and “only establishing a communication channel between the first party and second party through the particular line if the context is acceptable within the selection of context based criteria.”[Office Action, p. 14] The Examiner states that Morganstein does not “explicitly show regulating calls”, but cites Kurganov as teaching:

“a method and apparatus for a computer and telecommunications network (Title, abstract) that allows subscribers the ability to send and receive messages, access information and entertainment, conduct business transactions, organize daily schedules and stay in touch with homes and offices from anywhere at any time (col. 1 lines 26-56) from any standard communication device (col. 2 lines 24-34). Kurganov discloses the network based solution provides a contact database facilitating the placing of calls, screening of calls, and tracking you down wherever you are (col. 3 line 5- col. 4 line 63). Kurganov uses voice recognition software, standard touchtones, and internet for allowing subscribers access to features (col. 4 line 64 – col. 6 line 67).” [Office Action, pp. 14-15]

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The Examiner concludes that "it would have been obvious for anyone of ordinary skill in the art at the time of the invention to modify the processor as taught by Morganstein to use the network based solution as taught by Kurganov for the benefit of allowing user to subscribe to network based service as taught by Kurganov thereby providing for a more flexible system that allows subscribers the ability to stay in touch with homes and offices from any location as taught by Kurganov." [Office Action, p. 15]

**Morganstein combined with Kurganov does not teach or suggest all the limitations
of Claims 1, 6, and 11**

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. First, in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Appellants respectfully note that the Examiner does not show, nor do the references teach or suggest, separately or in combination, detecting a context for a call from a first party to a second party via a particular line, wherein a third party subscribes to a telephone service made available to said first party for said call or comparing said context for said call with a selection of context based criteria for said particular line specified by said third party.

First, Applicants respectfully assert that the Examiner's statement that the element missing in the teachings of Morganstein is "regulating calls" is incorrect, leading to a rejection that does not show how Morganstein in view of Kurganov teaches or suggests each and every element of claim 1. The Examiner cites Morganstein as teaching the elements of claim 1, except for wherein a third party subscribes to a telephone service made available to said first party for said call and a selection of context based criteria for said particular line specified by said third

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party. The Examiner improperly summarizes these elements as “regulating calls” and cites Kurganov as teaching “regulating calls”. These elements of claim 1, however, when claim 1 is considered as a whole, do not merely teach “regulating calls”. In particular, when claim 1 is considered as a whole, claim 1 teaches that the third party supplies the line used by the first party, or caller, for an outgoing call and that a communication channel is allowed to open for an outgoing call from the first party to the second party only if the context of the call between the first party and the second party is acceptable within a selection of context based criteria specified by the third party for the line.

Second, Applicants respectfully assert that neither Morganstein nor Kurganov, separately or in combination, teaches regulating outgoing calls placed by a first party according to third party context based criteria specified by a third party subscribing to the telephone service made available to the first party. First, Morganstein only discloses routing of an incoming call, not regulating outgoing calls. (See Morganstein abstract and col. 2, lines 15-59 where Morganstein enables a user to set how an incoming call is handled based on the caller telephone number). Second, Kurganov discloses a network through which a unified messaging service follows a subscriber to multiple devices. (See Kurganov abstract and col. 2 lines 29-34 and lines 42-46). Kurganov describes that a user may have a cellular phone, a pager, a computer, a fax machine, an electronic mailbox on the internet, and a voice mail service and Kurganov provides a unified messaging service accessible from any standard communication device (telephone, computer, internet). (Kurganov col. 2 lines 9-21, 29-34, and 42-46). In the area of outgoing calls, Kurganov describes that the unified messaging service provides a “contact database facilitating the placing of calls, screening of calls, and tracking you down wherever you are.” (Kurganov col. 3, lines 8-10). Thus, Kurganov discloses that a subscriber, or first party placing a call, may access the unified messaging service from any telephone device, and that the unified messaging service subscribed to by the first party provides a contact database for facilitating the placing of calls. Kurganov does not teach a third party subscriber to the telephone service used by the first party to place the call where the third party subscriber specifies context based criteria for

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regulating whether a communication channel is opened by the telephone service for the call to a second party.

In conclusion, a prima facie case of obviousness under 103(a) is not established for claims 1, 6, and 11 because at least one element of claims 1, 6, and 11 is not taught by Morganstein or Kurganov, separately or in combination. Because a prima facie case of obviousness under 103(a) is not established for the claims 1, 6, and 11, Appellants respectfully request allowance of claims 1, 6, and 11.

**There is No Reasonable Expectation of Success in the Proposed Combination of
Morganstein and Kurganov**

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Morganstein by Kurganov. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Claims 1, 6, and 11 teach a method, system, and program for regulating outgoing calls placed by a first party from a telephone service subscribed to by a third party, where the third party specifies criteria for regulating whether an outgoing communication channel is opened for the call. Morganstein discloses an automated call screening system for incoming calls. See Morganstein, abstract. Kurganov discloses a unified messaging service accessible from any standard communication device and offering a single point of access to all communications. See Kurganov, col. 2 lines 24-46. The Examiner states that "it would have been obvious for anyone of ordinary skill in the art at the time of the invention to modify the processor as taught by Morganstein to use the network based solution as taught by Kurganov for the benefit of allowing user to subscribe to network based service as taught by Kurganov thereby providing for a more flexible system that allows subscribers the ability to stay in touch with homes and offices from any location as taught by Kurganov." [Office Action, p. 15]

Applicants respectfully assert that the Examiner's statement of the combined invention of Morganstein and Kurganov shows that there is not any expectation of success for the proposed combination of the references to teach the claimed invention. In particular, modifying an

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automated call screening system for incoming calls so that the system is available via a network based service, as stated by the Examiner, does not teach the claimed invention of regulating outgoing calls placed by a first party from a telephone service subscribed to by a third party, where the third party sets the criteria for regulating whether an outgoing call is allowed. Therefore, the Examiner's conclusion as to the combined invention taught by Morganstein as modified by Kurganov shows that there is a lack of reasonable expectation of success in the proposed combination. As a result, the combination of Morganstein and Kurganov cannot establish a *prima facie* case of obviousness and the rejection of claims 1, 6, and 11 should be withdrawn.

Claims 2, 4, 5, 7, 9, 10, and 12

Regarding claims 2, 4, 5, 7, 9, 10, and 12, Applicants respectfully propose that because claims 1, 6, and 11 are no longer obvious under Morganstein in view of Kurganov, as claims dependent upon claims 1, 6, and 11, claims 2, 4, 5, 7, 9, 10, and 12 are not obvious under Morganstein in view of Kurganov and the dependent claims should be allowed.

Claim 14

With regard to claim 14, claim 14 currently reads:

14. (Original) A method for regulating outgoing calls, comprising:
 detecting an identity of a party called via a particular line;
 determining a selection of third party criteria governing calls via said particular line according to said identity of said called party; and
 only establishing a communication channel via said particular line between a calling party and called party if said called party is acceptable within said selection of third party criteria.

In the rejection of claim 14, the Examiner states that "Morganstein fails to show third party criteria." [Office Action, p. 16] The Examiner then cites Kurganov as teaching "a method and apparatus for a computer and telecommunications network (Title, abstract) that allows subscribers the ability to send and receive messages, access information and entertainment, conduct business transactions, organize daily schedules and stay in touch with homes and offices from anywhere at any time

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(col. 1 lines 26-56) from any standard communication device (col. 2 lines 24-34). Kurganov discloses the network based solution provides a contact database facilitating the placing of calls, screening of calls, and tracking you down wherever you are (col. 3 line 5- col. 4 line 63). Kurganov uses voice recognition software, standard touchtones, and internet for allowing subscribers access to features (col. 4 line 64 – col. 6 line 67).” [Office Action, pp. 16-17]

The Examiner concludes that “it would have been obvious for anyone of ordinary skill in the art at the time of the invention to modify the processor as taught by Morganstein to use the network based solution as taught by Kurganov for the benefit of allowing user to subscribe to network based service as taught by Kurganov thereby providing for a more flexible system that allows subscribers the ability to stay in touch with homes and offices from any location as taught by Kurganov.” [Office Action, p. 17]

**Morganstein combined with Kurganov does not teach or suggest all the limitations
of Claim 14**

In establishing a *prima facie* case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that *prima facie* obviousness is not established because Morganstein in view of Kurganov does not teach any of the claim limitations when claim 14 is considered as a whole.

First, Applicants respectfully assert that the Examiner fails to establish a case of *prima facie* obviousness for claim 14 because Morganstein does not teach all the elements of claim 14, except for “third party criteria”. In the rejection of claim 14, the Examiner assumes that Morganstein teaches claim 14, except for “third party criteria”. [Office Action, p. 5] While the Examiner does not point to which sections of Morganstein teach all the elements of claim 14 except for “third party criteria”, Applicants traverse the rejection and assert that when considered as a whole, claim 14 teaches regulating an outgoing call placed via a particular line based on the third party criteria governing calls via the outgoing line according to the identity of the called party receiving the call. Morganstein, in contrast, discloses call screening of incoming calls to a particular line based on the telephone number of the calling party, not regulating outgoing calls

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from a particular line. (See Morganstein col. 2, lines 15-59). Morganstein enables a user to set how an incoming call is handled based on the caller telephone number. (See Morganstein, abstract). Therefore, because Morganstein does not teach outgoing call regulation, Morganstein does not teach each element of claim 14 except for "third party criteria".

Second, Applicants respectfully assert that the Examiner fails to establish a case of *prima facie* obviousness for claim 14 because Kurganov does not teach "third party criteria" when claim 14 is interpreted as a whole and "third party criteria" is applied to regulating an outgoing call. In particular, as Applicants noted in the response to the rejection of claim 1, Kurganov discloses that a subscriber, or first party placing a call, may access a unified messaging service from any telephone device, and that the unified messaging service subscribed to by the first party provides a contact database for facilitating the placing of calls. (See Kurganov, abstract and col. 2 lines 9-46). Kurganov does not teach detecting the actual identity of the party answering a call, selecting from among the third party criteria based on the actual identity of the party answering the call, and enabling the call based on the criteria. In contrast, claim 14 teaches detecting the identity of the called party, selecting criteria according to the identity of the called party as set by a third party regulating outgoing calls from the particular line and only establishing a communication channel from the calling party to the called party if the identity of the called party is acceptable within the criteria. Therefore, because Kurganov does not teach regulating an outgoing call according to "third party criteria", Morganstein combined with Kurganov does not teach or suggest each element of claim 14.

In conclusion, Morganstein in view of Kurganov does not teach outgoing call regulation based on third party criteria applied to an outgoing call line. Therefore, *prima facie* case of obviousness under 103(a) is not established for claim 14 because at least one element of claim 14 is not taught. Because a *prima facie* case of obviousness under 103(a) is not established for claim 14, Appellants respectfully request allowance of claim 14.

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**There is No Reasonable Expectation of Success in the Proposed Combination of
Morganstein and Kurganov**

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed modification of Morganstein by Kurganov. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Claims 14 teaches a method for regulating outgoing calls placed by a first party from a telephone service subscribed to by a third party, where the third party specifies criteria for regulating whether an outgoing communication channel is opened for the call based on the identity of the called party. Morganstein discloses an automated call screening system for incoming calls. *See* Morganstein, abstract. Kurganov discloses a unified messaging service accessible from any standard communication device and offering a single point of access to all communications. *See* Kurganov, col. 2 lines 24-46. The Examiner states that “it would have been obvious for anyone of ordinary skill in the art at the time of the invention to modify the processor as taught by Morganstein to use the network based solution as taught by Kurganov for the benefit of allowing user to subscribe to network based service as taught by Kurganov thereby providing for a more flexible system that allows subscribers the ability to stay in touch with homes and offices from any location as taught by Kurganov.” [Office Action, p. 17]

Applicants respectfully assert that the Examiner’s statement of the combined invention of Morganstein and Kurganov shows that there is not any expectation of success for the proposed combination of the references to teach the claimed invention. In particular, modifying an automated call screening system for incoming calls so that the system is available via a network based service, as stated by the Examiner, does not teach the claimed invention of detecting the identity of the called party actually answering a call, selecting criteria according to the identity of the called party as set by a third party regulating outgoing calls from the particular line and only establishing a communication channel from the calling party to the called party if the identity of the called party is acceptable within the criteria. Therefore, the Examiner’s conclusion as to the combined invention taught by Morganstein as modified by Kurganov shows that there is a lack of reasonable expectation of success in the proposed combination. As a

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result, the combination of Morganstein and Kurganov cannot establish a *prima facie* case of obviousness and the rejection of claim 14 should be withdrawn.

Claims 16, 19, and 22

With regards to claims 16, 19, and 22, independent method claim 16, which is representative of independent system claim 19 and independent computer program product claim 22, with regard to similarly recited subject matter and rejection, reads as follows:

16. (Previously Amended) A method for screening calls, comprising:
detecting a context for a call from a first party to a second party, wherein
said context indicates at least one from among a location of said first party, a type
of telephony device used by said first party, and a device used to authenticate an
identity of said first party; and
responsive to said context requiring prescreening of said call, transferring
said call to a screening party.

In the rejection of claims 16, 19, and 22, the Examiner cites Morganstein as teaching:

“detecting a context for a call from a first party to second party (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 5 lines 1-36, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)”,
“comparing the context for the call with a selection of context based criteria for
particular line (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)”, and “only establishing a communication channel between the first party
and second party through the particular line if the context is acceptable within the
selection of context based criteria (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58).” [Office Action, pp. 17-18]

The Examiner notes, however, that Morganstein does not explicitly show a “call screener”.

[Office Action, p. 18] The Examiner then cites Kurganov as teaching:

“a method and apparatus for a computer and telecommunications network (Title,
abstract) that allows subscribers the ability to send and receive messages, access
information and entertainment, conduct business transactions, organize daily
schedules and stay in touch with homes and offices from anywhere at any time
(col. 1 lines 26-56) from any standard communication device (col. 2 lines 24-34).
Kurganov discloses the network based solution provides a contact database
facilitating the placing of calls, screening of calls, and tracking you down

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wherever you are (col. 3 line 5- col. 4 line 63). Kurganov uses voice recognition software, standard touchtones, and internet for allowing subscribers access to features (col. 4 line 64 – col. 6 line 67).” [Office Action, p. 18]

The Examiner concludes that “it would have been obvious for anyone of ordinary skill in the art at the time of the invention to modify the processor as taught by Morganstein to use the network based solution as taught by Kurganov for the benefit of allowing user to subscribe to network based service as taught by Kurganov thereby providing for a more flexible system that allows subscribers the ability to stay in touch with homes and offices from any location as taught by Kurganov.” [Office Action, p. 18]

**Morganstein combined with Kurganov does not teach or suggest all the limitations
of Claims 16, 19, and 22**

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that the Examiner nor the references teach or suggest, separately or in combination, detecting a context for a call from a first party to a second party, wherein said context indicates at least one from among a location of said first party, a type of telephony device used by said first party, and a device used to authenticate an identity of said first party.

In particular, the Examiner does not point out, nor does Morganstein teach a context indicating at least one from among a location of said first party, a type of telephony device used by said first party, and a device used to authenticate an identity of said first party. Additionally, the Examiner does not point out, nor does Kurganov teach a context indicating at least one from among a location of said first party, a type of telephony device used by said first party, and a device used to authenticate an identity of said first party. In conclusion, prima facie case of obviousness under 103(a) is not established for claim 16 because at least one element of claim 16 is not taught. Because a prima facie case of obviousness under 103(a) is not established for claim 16, Appellants respectfully request allowance of claims 16, 19, and 22.

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**There is No Reasonable Expectation of Success in the Proposed Combination of
Morganstein and Kurganov**

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed modification of Morganstein by Kurganov. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Claims 16, 19, and 22 teach a method, system, and program for regulating which calls are prescreened according to a context indicating at least one from among a location of said first party, a type of telephony device used by said first party, and a device used to authenticate an identity of said first party. Morganstein discloses an automated call screening system for incoming calls. See Morganstein, abstract. Kurganov discloses a unified messaging service accessible from any standard communication device and offering a single point of access to all communications. See Kurganov, col. 2 lines 24-46. The Examiner states that "it would have been obvious for anyone of ordinary skill in the art at the time of the invention to modify the processor as taught by Morganstein to use the network based solution as taught by Kurganov for the benefit of allowing user to subscribe to network based service as taught by Kurganov thereby providing for a more flexible system that allows subscribers the ability to stay in touch with homes and offices from any location as taught by Kurganov." [Office Action, p. 18]

Applicants respectfully assert that the Examiner's statement of the combined invention of Morganstein and Kurganov shows that there is not any expectation of success for the proposed combination of the references to teach the claimed invention. Neither Morganstein, Kurganov, or the combination proposed by the Examiner teach detecting a context for a call from a first party to a second party where the context indicates at least one from among a location of said first party, a type of telephony device used by said first party, and a device used to authenticate an identity of said first party. Therefore, the Examiner's conclusion as to the combined invention taught by Morganstein as modified by Kurganov shows that there is a lack of reasonable expectation of success in the proposed combination. As a result, the combination of Morganstein and Kurganov cannot establish a *prima facie* case of obviousness and the rejection of claims 16, 19, and 22 should be withdrawn.

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Claims 17, 18, 20, 21, 23, and 24

Regarding claims 17, 18, 20, 21, 23, and 24, Applicants respectfully propose that because Morganstein in view of Kurganov no longer anticipates the independent claims 16, 19 and 22 upon which these dependent claims rely, then Morganstein in view of Kurganov does not anticipate these dependent claims 17, 18, 20, 21, 23, and 24 and the dependent claims should be allowed.

Claims 25, 35, and 45

With regards to claims 25, 35, and 45, independent method claim 25, which is representative of independent system claim 35 and independent computer program product claim 45, with regard to similarly recited subject matter and rejection, reads as follows:

25. **(Currently Amended)** A method for regulating calls, comprising:
detecting an identity of a caller placing a call from a particular line number, wherein a third party independent of said caller subscribes for said particular line number;
accessing regulation criteria specified by said third party and relevant to said caller identity for said particular line number; and
regulating said call according to said relevant regulation criteria, such that said third party is enabled to regulate calls [to] from said particular line number without being a direct party to said call.

Regarding the rejection of claim 25, the Examiner cites Morganstein as teaching

“detecting a context for a call from a first party to second party (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 5 lines 1-36, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)”,
“comparing the context for the call with a selection of context based criteria for particular line (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)”, and “only establishing a communication channel between the first party and second party through the particular line if the context is acceptable within the selection of context based criteria (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58).” [Office Action, pp. 20-21]

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The Examiner does not cite what element of claim 25 is not taught by Morganstein, but the Examiner cites Kurganov as teaching

“a method and apparatus for a computer and telecommunications network (Title, abstract) that allows subscribers the ability to send and receive messages, access information and entertainment, conduct business transactions, organize daily schedules and stay in touch with homes and offices from anywhere at any time (col. 1 lines 26-56) from any standard communication device (col. 2 lines 24-34). Kurganov discloses the network based solution provides a contact database facilitating the placing of calls, screening of calls, and tracking you down wherever you are (col. 3 line 5- col. 4 line 63). Kurganov uses voice recognition software, standard touchtones, and internet for allowing subscribers access to features (col. 4 line 64 – col. 6 line 67).” [Office Action, p. 21]

The Examiner concludes that “it would have been obvious for anyone of ordinary skill in the art at the time of the invention to modify the processor as taught by Morganstein to use the network based solution as taught by Kurganov for the benefit of allowing user to subscribe to network based service as taught by Kurganov thereby providing for a more flexible system that allows subscribers the ability to stay in touch with homes and offices from any location as taught by Kurganov.” [Office Action, pp. 21-22]

Morganstein combined with Kurganov does not teach or suggest all the limitations of Claims 25, 35, and 45

In establishing a *prima facie* case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that neither Morganstein nor Kurganov teaches regulating an outgoing call placed via a particular line based on the third party criteria governing calls by the identified caller via the outgoing line. First, Morganstein only discloses routing of an incoming call, not regulating outgoing calls. (See Morganstein abstract and col. 2, lines 15-59 where Morganstein enables a user to set how an incoming call is handled based on the caller telephone number). Second, Kurganov discloses a network through which a unified messaging service follows a subscriber to multiple devices. (See Kurganov abstract and col. 2 lines 29-34 and lines 42-46). Kurganov describes that a user may have a cellular phone, a

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pager, a computer, a fax machine, an electronic mailbox on the internet, and a voice mail service and Kurganov provides a unified messaging service accessible from any standard communication device (telephone, computer, internet). (Kurganov col. 2 lines 9-21, 29-34, and 42-46). In the area of outgoing calls, Kurganov describes that the unified messaging service provides a "contact database facilitating the placing of calls, screening of calls, and tracking you down wherever you are." (Kurganov col. 3, lines 8-10). Thus, Kurganov discloses that a subscriber, or first party placing a call, may access the unified messaging service from any telephone device, and that the unified messaging service subscribed to by the first party provides a contact database for facilitating the placing of calls. Kurganov does not teach a third party subscriber to the telephone service, where the third party subscriber regulates use of the line based on the identity of the caller. Therefore, Morganstein as modified by Kurganov also does not teach regulating an outgoing call placed via a particular line based on the third party criteria governing calls by the identified caller via the outgoing line

In conclusion, *prima facie* case of obviousness under 103(a) is not established for claim 25 because at least one element of claim 25 is not taught. Because a *prima facie* case of obviousness under 103(a) is not established for claim 25, Appellants respectfully request allowance of claims 25, 35, and 45.

**There is No Reasonable Expectation of Success in the Proposed Combination of
Morganstein and Kurganov**

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed modification of Morganstein by Kurganov. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Claims 25, 35, and 45 teach a method, system, and program for regulating outgoing calls placed by an identified caller from a telephone service subscribed to by a third party, where the third party specifies criteria for regulating whether an outgoing communication channel is opened for that particular identified caller. Morganstein discloses an automated call screening system for incoming calls. See Morganstein, abstract. Kurganov discloses a unified messaging service accessible from any standard

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communication device and offering a single point of access to all communications. See Kurganov, col. 2 lines 24-46. The Examiner states that "it would have been obvious for anyone of ordinary skill in the art at the time of the invention to modify the processor as taught by Morganstein to use the network based solution as taught by Kurganov for the benefit of allowing user to subscribe to network based service as taught by Kurganov thereby providing for a more flexible system that allows subscribers the ability to stay in touch with homes and offices from any location as taught by Kurganov." [Office Action, pp. 21-22]

Applicants respectfully assert that the Examiner's statement of the combined invention of Morganstein and Kurganov shows that there is not any expectation of success for the proposed combination of the references to teach the claimed invention. In particular, modifying an automated call screening system for incoming calls so that the system is available via a network based service, as stated by the Examiner, does not teach the claimed invention of regulating outgoing calls placed by an identified caller from a telephone service subscribed to by a third party, where the third party sets the criteria for regulating whether an outgoing call is allowed for that particular identified caller. Therefore, the Examiner's conclusion as to the combined invention taught by Morganstein as modified by Kurganov shows that there is a lack of reasonable expectation of success in the proposed combination. As a result, the combination of Morganstein and Kurganov cannot establish a *prima facie* case of obviousness and the rejection of claims 25, 35, and 45 should be withdrawn.

Claims 26, 30-34, 36, 40-44, 46, and 50-54

Regarding claims 26, 30-34, 36, 40-44, 46, and 50-54, Applicants respectfully propose that because Morganstein in view of Kurganov no longer anticipates the independent claims 25, 35, and 45 upon which these dependent claims rely, then Morganstein in view of Kurganov does not anticipate these dependent claims 26, 30-34, 36, 40-44, 46, and 50-54 and the dependent claims should be allowed.

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3. Claims 55-65 are not obvious under Morganstein in view of Kurganov and further in view of Farris

Claims 55-65 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morganstein (US Patent Number 5,724,408) in view of Kurganov (US Patent Number 6,807,257) and further in view of Farris et al. (6,122,357, hereinafter Farris). The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Regarding claims 55-65, Applicants respectfully propose that because independent claims 1, 6, and 11 are not obvious under Morganstein in view of Kurganov, then these dependent claims 55-65 which on claims 1, 6, and 11 are also not obvious under Morganstein in view of Kurganov and Farris and the dependent claims should be allowed.

In addition, regarding claims 55 and 60, the Examiner cites Morganstein in view of Kurganov as failing to teach “the context comprises location of the caller and the callee.” [Office Action, p. 25] Regarding claims 57 and 62, the Examiner cites Morganstein in view of Kurganov as failing to teach the context comprising the “type of telephony device.” [Office Action, p. 27] In addition, regarding claims 58 and 63, the Examiner cites Morganstein in view of Kurganov as failing to teach context comprising the “type of billing plan.” [Office Action, p. 27]

Following each statement of what Morganstein in view of Kurganov teaches, with regard to claims 55, 57-60, 62-65, the Examiner rejects each claim on the same basis that:

Farris teaches providing enhanced services through double SIV and personal dial tone (title, abstract) wherein the identity of a caller and callee is determined via speaker identification/verification (SIV) on audio signals received from users (col. 11 lines 32-42, col. 35 lines 18-40) enabling for call restrictions to be implanted from any location and different types of telephony devices (see pay-phone or hotel room telephony – column 14). Farris discloses the service may utilize a variety of different networks (col. 8 lines 12-14).

It would have been obvious for anyone of ordinary skill in the art at the time of the invention to modify the processor as taught by Morganstein in view of Kurganov to use double SIV as taught by Farris for the benefit of authenticating both the caller and callee parties and thereby providing for a more flexible system

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that "challenges" both the callee and calling party before implementing call restrictions as taught by Farris." [Office Action, pp. 26, 27, 28, 29]

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that a prima facie case of obviousness is not established because Farris does not teach the elements in claims 55-65 that Morganstein in view of Kurganov fail to teach. In particular, Applicants respectfully assert that Farris teaching a services that detects the identity of the caller and callee to enable call restrictions from any location and from different types of telephony device, does not mean that Farris also teaches detecting a context of a call that includes the location of the caller and callee, the types of telephony devices, or the billing plan available. With regard to claims 55 and 60, 57 and 62, and 58 and 63, Applicants respectfully assert that neither Morganstein, Kurganov nor Farris teaches detecting a context for a call wherein the context detected comprises the location of the caller and the callee, the types of telephony devices used or the type of billing plan available. In conclusion, prima facie case of obviousness under 103(a) is not established for claims 55, 57-60, 62-65 because at least the elements cited by the Examiner as not taught by Morganstein in view of Kurganov are also not taught by Farris. Because a prima facie case of obviousness under 103(a) is not established for claims 55, 57-60, 62-65, Appellants respectfully request allowance of claims 55, 57-60, 62-65.

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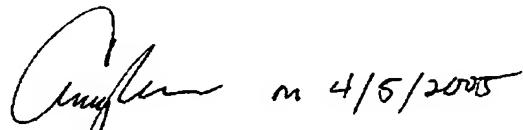
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Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims are respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,



4/5/2005

Amy J. Pattillo
Attorney for Applicants
Reg. No 46,983
P.O. Box 161327
Austin, Tx 78716
512.402.9820 *vox*
512.306.0417 *fax*

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